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03/11/2004

Evan Pennell

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/798,864
Filing Date: March 11, 2004
Appellant(s): PENNELL ET AL.

Geoffrey P. Shipsides
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 22, 2008 appealing from the Office action mailed October 04, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,276,061	ROZENKRANC	8-2001
2004/0055156	BROWN, JR	3-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 35-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown, Jr. (US 2004/0055156).

Brown discloses all the recited elements of the invention including a housing having a primary guard (e.g. 26), a primary cap (e.g. 29), and one or more primary shaving blades (e.g. 7-9), a blade carrier (e.g., at 4) defining a rear wall having a rear exterior surface extending downward to a terminating surface and extending along substantially the entire length of a trimming blade (e.g., see Fig. 2, 36) and defining a trimming cap (e.g., 34).

Claims 1, 3, 5, 12-13, 24, 27-29, 32-33, and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rozenkranc (US 6,276,061).

Rozenkranc discloses the invention substantially as claimed including a housing having a primary guard (e.g., at 6) and a primary cap (e.g., at 5), one or more primary shaving blades (e.g., 3), a rear wall having a rear exterior surface extending along substantially the entire length of the trimming blade and defining a trimming cap (e.g., Figure 3a, unlabeled), a trimming blade having a trimming cutting edge (e.g., 4), and a trimming guard (e.g., Figure 3a, unlabeled). Rozenkranc fails to disclose an assembly mountable on the housing wherein the assembly comprising a blade carrier formed from sheet metal. However, it would have been obvious matter of design choice to a person of ordinary skill in the art to provide a separate assembly including a blade carrier made of sheet metal instead of an integral structure made of the same material because applicant has not disclosed the separate assembly including the blade carrier made of sheet metal provides an advantage, is used for particular purpose, or solves a stated

problem. One of ordinary skill in the art would have expected Rozenkranc's arrangement and applicant's invention, to perform equally well with either arrangement since both arrangements would have performed the same function. Applicants also disclose (paragraph 8) the assembly integrally formed of the same material as the housing as an alternative structure. Furthermore, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179 and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In *re Leshin*, 125 USPQ 416. Regarding claim 24, the modified device of Rozenkranc teaches alignment surfaces (e.g., surfaces on an unlabeled blade holder at 4). Regarding claims 27-28, the modified device of Rozenkranc teaches a shaving aid strip (e.g., 5). Regarding claims 32-33, e.g., Figure 1 of Rozenkranc.

Claims 1, 3, 5, 12-13, 24, 27-30, and 32-33 are rejected under 35

U.S.C. 103(a) as being unpatentable over Brown, Jr. (US 2004/0055156).

Brown discloses the invention substantially as claimed including a housing having a primary guard (e.g. 26), a primary cap (e.g. 29), and one or more primary shaving blades (e.g. 7-9), a blade carrier (e.g., at 4) defining a rear wall having a rear exterior surface extending downward to a terminating surface and extending along substantially the entire length of a trimming blade (e.g., see Fig. 2, 36) and defining a trimming cap (e.g., 34). Brown fails to disclose the blade carrier formed from sheet metal. However, it would have been obvious matter of design choice to a person of

ordinary skill in the art to provide the blade carrier made of sheet metal because applicant has not disclosed the blade carrier made of sheet metal provides an advantage, is used for particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected Brown's arrangement and applicant's invention, to perform equally well with either arrangement since both arrangements would have performed the same function. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. Regarding claim 5, the modified device of Brown teaches a trimming guard (e.g., 33). Regarding claims 27-28, the modified device of Brown teaches a strip (e.g., paragraph 24). Regarding claim 30, e.g., see paragraph 20 of Brown.

Claims 1, 3, 5, 7-8, 12-13, 24, 27-33, and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rozenkranc in view of Applicant's Admitted Prior Art (hereafter AAPA).

In alternative, if it is argued that Rozenkranc does not teach the rear exterior surface extending along substantially the entire length of the trimming blade, Rozenkranc discloses the invention substantially as claimed including a housing having a primary guard (e.g., at 6) and a primary cap (e.g., at 5), one or more primary shaving blades (e.g., 3), a rear wall having a rear exterior surface and defining a trimming cap (e.g., Figure 3a, unlabeled), a trimming blade having a trimming cutting edge (e.g., 4), and a trimming guard (e.g., Figure 3a, unlabeled). Rozenkranc fails to disclose an assembly mountable on the housing wherein the

assembly comprising a blade carrier formed from sheet metal. However, it would have been obvious matter of design choice to a person of ordinary skill in the art to provide a separate assembly including a blade carrier made of sheet metal instead of an integral structure made of the same material because applicant has not disclosed the separate assembly including the blade carrier made of sheet metal provides an advantage, is used for particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected Rozenkranc's arrangement and applicant's invention, to perform equally well with either arrangement since both arrangements would have performed the same function. Applicants also disclose (paragraph 8) the assembly integrally formed of the same material as the housing as an alternative structure. Furthermore, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179 and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Moreover, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the rear exterior surface extending along substantially the entire length of the trimming blade on the device of Rozenkranc since providing a rear exterior surface extending along substantially the entire length of a blade or blades as old and well known in the art for the purpose of providing a blade supporting body as admitted by the applicant. *Apprille, Carson, and Metcalf* show examples of a commercially available multi-blade shaving apparatus with a

rear exterior surface extending along substantially the entire length of blades. It is noted that the common knowledge or well-known in the art statement of the previous office action has been taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. See MPEP § 2144.03. Regarding claims 7-8, the modified device of Rozenkranc discloses the invention substantially as claimed except for one or more skin protection structures between the trimming guard and the trimming cutting edge. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ one or more skin protection structures between the trimming guard and the trimming cutting edge as taught by AAPA on the modified device of Rozenkranc in order to protect the user's skin. Regarding claims 30-31, the modified device of Rozenkranc fails to disclose four or more primary shaving blades or five or more primary shaving blades. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ four or five or more primary blades as taught by AAPA on the modified device of Rozenkranc in order to enhance shaving action. It is noted that the common knowledge or well-known in the art statement of the previous office action of August 12, 2005 has been taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of Official Notice or that the traverse was inadequate. See MPEP § 2144.03.

Claims 7-8 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of AAPA.

Regarding claims 7-8, the modified device of Brown discloses the invention substantially as claimed except for one or more skin protection structures between the trimming guard and the trimming cutting edge. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ one or more skin protection structures between the trimming guard and the trimming cutting edge as taught by AAPA on the modified device of Brown in order to protect the user's skin. Regarding claim 31, the modified device of Brown fails to disclose five or more primary shaving blades. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ five or more primary blades as taught by AAPA on the modified device of Brown in order to enhance shaving action. It is noted that the common knowledge or well-known in the art statement of the previous office action of August 12, 2005 has been taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. See MPEP § 2144.03.

(10) Response to Argument

The examiner disagrees with appellants' argument regarding the rejection of independent claim 35 over Rozenkranc.

Appellants contend that Rozenkranc does not provide any enabling teaching or suggestion that there is a cutting edge of a trimming blade inside of an imaginary extension of a terminating surface of a rear wall and the trimming blade is not mounted on the rear wall. Appellants argue that the claim 35 calls for the housing being distinct and separate from the claimed assembly. Appellants further argue that there is no

motivation to modify the device of Rozenkranc to provide a separate structure for the assembly.

As shown on Figure A below, Rozenkranc does show the cutting edge of the trimming blade inside of the imaginary extension of the terminating surface. A head body (2) includes the housing portion with the primary guard, the primary cap, and the primary blades and the integrally attached assembly portion includes the blade carrier defining the rear wall as claimed and the trimming blade as claimed. Furthermore, the trimming blade of Rozenkranc is mounted on the rear wall including the rear exterior surface as shown below since the blade is mounted within the assembly portion (i.e., the blade is mounted to all parts of the assembly portion by their common connection). Moreover, since the appellants have not demonstrated the criticality of having a separate structure, it is appropriate for the examiner to rely solely on the rationale used by the court to support an obviousness rejection. It is noted that the appellants have also disclosed an integrally formed structure as an alternative embodiment (e.g., paragraph 8 of the specification).

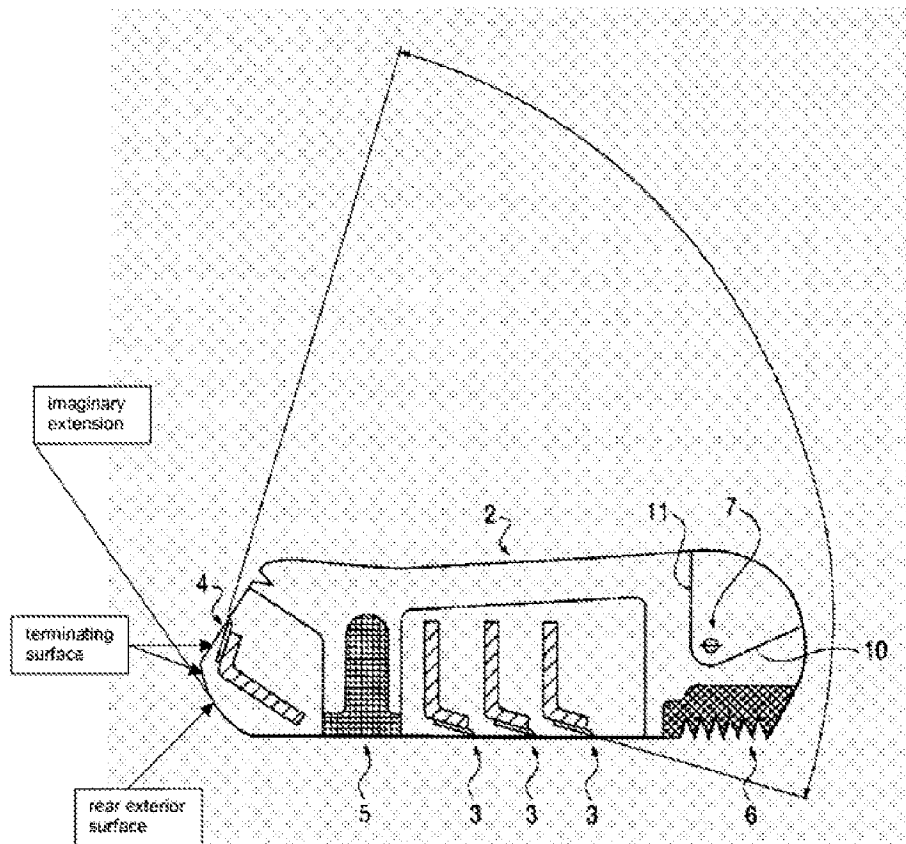


Figure A

The examiner disagrees with appellants' argument regarding the rejection of independent claim 1 over Rozenkranc.

Appellants contend that the examiner's rejection is improper because the examiner has not satisfied the burden of presenting a *prima facie* case of obviousness.

The examiner disagrees with the appellants' argument for the same reasons set forth above in view of Rozenkranc. The appellants fail to provide evidence of nonobviousness for providing a separate structure wherein the blade carrier is made of sheet metal. Hence, it is appropriate for the examiner to rely solely on the rationale

used by the court to support an obviousness rejection. It is noted that the appellants have also disclosed an integrally formed structure as an alternative embodiment (e.g., paragraph 8 of the specification). Since it has been held that constructing a formerly integral structure into various elements and selecting a known material to suit the intended use involves only routine skill in the art, it is the examiner's position that one having ordinary skill in the art would have been motivated to provide the separately mountable structure with the blade carrier made of sheet metal to arrive at the claimed invention.

The examiner disagrees with appellants' argument regarding the rejection of independent claim 36 over Rozenkranc.

Appellants argue that Rozenkranc does not include a trimming assembly which includes a trimming blade and a trimming guard as a unitary piece attached to the housing.

The examiner disagrees with the appellants' argument for the same reasons set forth above in view of Rozenkranc. Rozenkranc teaches the head body (2) including the housing portion with the primary guard, the primary cap, and the primary blades and the assembly portion including the blade carrier integrally attached to the back of the housing portion. Furthermore, it is appropriate for the examiner to rely solely on the rationale used by the court to support an obviousness rejection since the appellants have not provided evidence of nonobviousness. It is noted that the appellants have also disclosed an integrally formed structure as an alternative embodiment (e.g., paragraph 8 of the specification).

The examiner disagrees with appellants' argument regarding the rejection of independent claim 3 over Rozenkranc.

Appellants argue that there is no motivation to modify Rozenkranc as set forth in the examiner's rejection.

The examiner disagrees with the appellants' argument for the same reasons set forth above in view of Rozenkranc. Since it has been held that constructing a formerly integral structure into various elements and selecting a known material to suit the intended use involves only routine skill in the art, it is the examiner's position that one having ordinary skill in the art would have been motivated to provide the separately mountable structure with the blade carrier made of sheet metal to arrive at the claimed invention. It is appropriate for the examiner to rely solely on the rationale used by the court to support an obviousness rejection wherein the appellants have failed to provide evidence of nonobviousness.

The examiner disagrees with appellants' argument regarding the rejection of claim 1, 3, 5, 7-8, 12-13, 24, 27-33, 35, and 36 over Rozenkranc in view of AAPA.

Appellants argue that it would not have been obvious to one of ordinary skill in the art to provide the blade carrier extending along the entire length as claimed because the top portion of Rozenkranc does not support the blade.

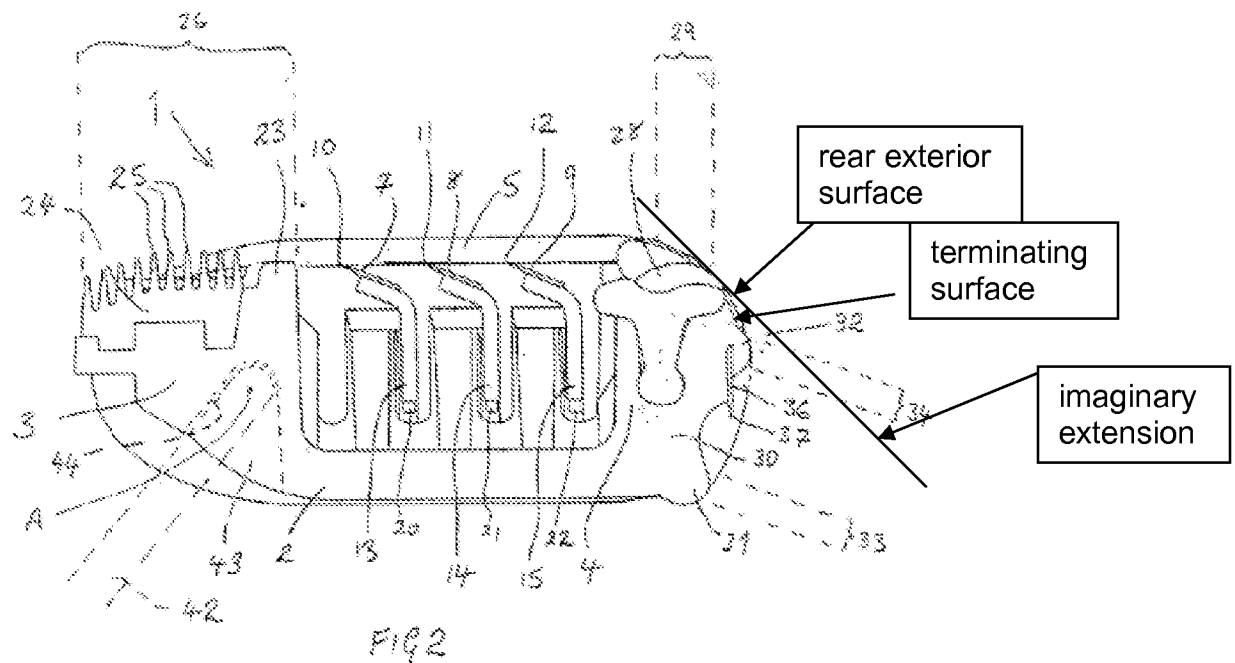
The examiner disagrees with the appellants' argument for the same reasons set forth above in view of Rozenkranc. The appellants have admitted that providing the blade carrier that extends along the entire length of the blade is old and well known in the art. Hence, the modified device of Rozenkranc with the assembly attached to the

housing teaches the blade carrier as claimed. The examiner rejection does not propose mounting the blade on the top portion of the housing in Rozenkranc.

The examiner disagrees with appellants' argument regarding the rejection of claims 35 and 36 over Brown.

Appellants argue that Brown does not disclose the claimed assembly including the claimed blade carrier and the claimed housing.

Brown teaches the claimed trimming assembly that is integrally attached to the claimed housing. Furthermore, Brown does show the blade carrier defining the rear wall having the rear exterior surface extending downward to the terminating surface as shown below.



Moreover, the trimming cutting edge (e.g., 37) extends at least partially beyond the terminating surface inside the imaginary extension as set forth above. The trimming

blade is mounted on the rear wall since the blade is embedded within the blade carrier portion of rear member (e.g., 4). In addition, Brown clearly shows a distinct trimming assembly that includes the blade carrier and the trimming guard as part of a unitary construction as requires by claim 36.

The examiner disagrees with appellants' argument regarding the rejection of claims 1 and 3 over Brown.

Appellants contend that Brown does not disclose a distinct assembly from the housing that includes the claimed blade carrier and no reason to modify to provide the blade carrier formed from sheet metal.

The examiner disagrees with the appellants' argument for the same reasons set forth above in view of Brown. Brown does disclose a distinct assembly including the blade carrier that is integrally attached to the housing. Furthermore, since it has been held that selecting a known material to suit the intended use involves only routine skill in the art, it is the examiner's position that one having ordinary skill in the art would have been motivated to provide the blade carrier made of sheet metal to arrive at the claimed invention. It is noted that it is appropriate for the examiner to rely solely on the rationale used by the court to support an obviousness rejection wherein the appellants have failed to provide evidence of nonobviousness.

The examiner disagrees with appellants' argument regarding the rejection of claims 7-8 and 31 over Brown in view of AAPA.

The examiner disagrees with the appellants' argument for the same reasons set forth above in view of Brown.

Art Unit: 3700

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Stephen Choi/

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